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REMARKS

In this Response new claims 26-34 are presented. After entry of the above amendments this application will contain claims 1, 3-6, 8-15, 20, 24, 25-34 pending and under consideration. Claims 1, 3-6, 8-15, 20, 24, and 25 were rejected under 35 U.S.C. §103(a) over Sohnius (U.S. 3,607,741) in view of Rowell (EPO 213,252). Objections were raised to claim 17 for being dependent upon a rejected base claims, but claim 17 was indicated as being allowable if rewritten in independent form and to include all the limitations of the base claim 1. For more reasons more fully discussed below, it is believed that all of these rejections are overcome and their withdrawal is requested.

Interview Summary

The undersigned wishes to express his appreciation for considerations extended by the Examiner during the interviews of April 22, 2004 and May 18, 2004. The interview summary dated May 28, 2004 fairly describes the substance of the April 22 interview. In addition, the undersigned notes that the Examiner indicated that he would consider comparative data derived from the oil gathering ability of material prepared as described in the Sohnius reference to material prepared as in Sohnius which has been further modified as claimed in the Applicants' application.

Rejections Under 35 USC §103

Claims 1, 3-6, 8-15, 20, 24, and 25 were rejected under 35 U.S.C. §103(a) over Sohnius (US 3,607,741) in view of Rowell (EP 213,252). Applicants respectfully maintain that Sohnius in combination with Rowell do not make the claimed invention obvious.

The Applicants previously presented a Declaration of Mr. Richard Salisbury. However in the Advisory Action dated, Jan 23, 2004, the results of the affidavit were not considered to be persuasive because 1) it is not readily apparent that a comparison of Sohnius's material both with and without esterification of hydroxyl groups in this material has been made, and 2) that the claims are limited to the specific material (i.e., acetylated wood fiber) for which the Applicants attempted to demonstrate new and unexpected results. (Advisory Action, page 2)

The Applicants request reconsideration of the Affidavit. Regarding the request to compare the Sohnius material to the Sohnius material that has been treated according to the claimed invention. The Examiner is requesting that the Applicants prepare a material (i.e. the Sohnius material treated according to the claimed invention) that is not in the prior art. There is no procedure to prepare such material. As noted in Mr. Salisbury's Affidavit and supported by Sohnius, the Sohnius material is difficult to prepare. Among other things, the Sohnius procedure includes separating pretreating the paper pulp and fiber with emulsifiers and the water repellent and then combining the two and then subsequently further treatment. (Sohnius, col. 1, line 75-col. 2, line 67.) The water repellent includes: silicone, paraffin, stearate, and an emulsifier. At what point should the wood fiber and/or paper pulp be treated according to the Applicants' claimed invention either before treatment with the emulsifier and water repellent, after this treatment, prior to combining the two pretreated materials or after drying the combined materials? There is no procedure to follow to prepare this new material to compare with the original Sohnius material.

In contrast, what the Applicants' have done is to essentially prepare material as described in their application, i.e. acetylated wood fiber. (See Application, Example 1 page 5.) As a specific Example in the application, this material should be sufficient to compare with that of the closed prior art, without having to resort to preparing a completely new material that is not in the prior art and for which no preparation has been established.

Further what is being requested is actually to prepare material that is derived from the teachings of the two references Sohnius and Rowell. Sohnius has been described above. Rowell teaches acetylating fiber. It is believed that this should not be required. In re Chapman, 148 USPQ 711, 714 (CCPA 1966) and MPEP 716.02(e).

Accordingly, reconsideration of the claims is requested in light of the previously submitted Affidavit. The undersigned attorney respectfully requests that the rejections over claims 1, 3-6, 8-15, 20, 24, and 25 be withdrawn over Sohnius (U.S. 3,607,741) in view of Rowell (EPO 213,252).

New Claims

New claims 26-34 have been presented. Claim 26 is directed to a method of absorbing hydrophobic water-immiscible liquids using a material consisting essentially of wood fiber which has been modified by esterification. It is believed that this claim is fully supported by the specification and is commensurate with the scope of the data present in the Affidavit.

New claim 34 is supported by claims 1 and 17. Claim 17 was objected to for being dependent upon a rejected base claim but otherwise considered allowable.

Conclusion

In view of the foregoing discussion, reconsideration, and withdrawal of all outstanding rejections, and allowance of this application containing claims 1, 3-6, 8-15, 17, 20, 24, 25-34 are requested. In addition, the Examiner is invited to telephone the undersigned attorney if there are any questions about this submission and other formal matters, which might be addressed in that fashion to facilitate allowance of this application.

Respectfully submitted,

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